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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/111,298 08/23/93 COATES

V 8196R

DUNN, D EXAMINER

25M1/0103

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22693 HESPERIAN BLVD., #270  
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ART UNIT PAPER NUMBER

2506

DATE MAILED: 01/03/94

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

- ☒ This application has been examined ☐ Responsive to communication filed on \_\_\_\_\_ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire THREE month(s), 0 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- ☒ Notice of References Cited by Examiner, PTO-892.
- ☒ Notice re Patent Drawing, PTO-948.
- ☐ Notice of Art Cited by Applicant, PTO-1449.
- ☐ Notice of Informal Patent Application, Form PTO-152.
- ☐ Information on How to Effect Drawing Changes, PTO-1474.
- ☐

Part II SUMMARY OF ACTION

- ☒ Claims 1-7 are pending in the application.  
Of the above, claims \_\_\_\_\_ are withdrawn from consideration.
- ☐ Claims \_\_\_\_\_ have been cancelled.
- ☐ Claims \_\_\_\_\_ are allowed.
- ☒ Claims 1-7 are rejected.
- ☐ Claims \_\_\_\_\_ are objected to.
- ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.
- ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
- ☐ Formal drawings are required in response to this Office action.
- ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
- ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
- ☐ The proposed drawing correction, filed on \_\_\_\_\_, has been ☐ approved. ☐ disapproved (see explanation).
- ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received  
☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
- ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
- ☐ Other

A shortened statutory period for response to this action is set to expire three months from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. § 133

The reissue declaration filed with this application is defective because it fails to particularly specify the errors relied upon as it fails to state every error, as required under 37 C.F.R. § 1.175(a)(5). Applicant fails to specifically specify every error relied upon (*i.e.* the amendments to specification seen in column 1).

Further, the reissue declaration filed with this application is defective because it fails to particularly specify how the errors relied upon arose or occurred, as required under 37 C.F.R. § 1.175(a)(5). Applicant's statement on page 3 paragraph 4 of the declaration fails to adequately state how the error arose. As best understood, examiner is led to believe that the illustrator described the invention, drafted the figures and applicant's representative drafted the specification and claims from the illustrator's drawings. Also, the term "recently" is unclear in view of the two years between the date of the printed patent to the filing date of the reissue. Further, the declaration fails to state when the errors were found as required by 37 C.F.R. § 1.175.

Claims 1-7 are rejected as being based upon a defective reissue declaration under 35 U.S.C. § 251. See 37 C.F.R. § 1.175.

The reissue specification filed 23 August 1993 is objected to under 35 U.S.C. § 132 because it introduces new matter into the specification. 35 U.S.C. § 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: on line 35 of the amended column 1, the deletion of "or aluminum specimen" is deemed new matter. Further,

the addition of "high reflectance (thus, high signal-to-noise), specular reference material with stable reflectivity over a long term and with well known optical constants" is deemed new matter since the originally filed specification only provides support for a "single crystal silicon" or "aluminum specimen".

Applicant is required to amend the new matter in the specification in the response to this Office action. Under section 1411.02 of the M.P.E.P. "New Matter":

New matter, that is, matter not present in the patent sought to be reissued, is excluded from a reissue application in accordance with 35 U.S.C. 251.

The claims in the reissue application must also be for matter which the applicant had the right to claim in the original patent. **New matter may exist by virtue of the omission of a feature** or of a step in a method. See United States Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corp., 315 U.S. 668, 53 USPQ 6 (1942).

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected under 35 U.S.C. § 112, first paragraph, as the specification, as originally filed, does not provide support for the invention as is now claimed.

Claims 1-7 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification. Claims 1-5 and 7, in reciting "material", the meaning according to the specification is not supported by the specification as originally

filed. The recitation in claim 6 is not supported by the specification as originally filed. This is a new matter rejection.

Claims 1-5 and 7 would be allowable if rewritten or amended to overcome the rejection under 35 U.S.C. § 112. Applicant should note that the dependency of claim 7 must be amended should claim 6 be deleted.

The following is an Examiner's Statement of Reasons for <sup>allowability</sup> ~~Allowance~~ though the prior art is concerned with the measurements of absolute reflectance, it fails to suggest the measurement of absolute reflectance by use of ultraviolet light in correlation with a comparison to a standard that corrects for optical efficiency.

Applicant is notified that any subsequent amendment to the specification and/or claims must comply with 37 C.F.R. § 1.121(e).


Papers related to this application may be submitted to Group 2500 by facsimile transmission. Papers should be faxed to the Group 2500 Fax Center. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 34-35 (November 15, 1988). The Group 2500 Fax Center numbers are (703) 305-3594 and (703) 308-1753.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Drew A. Dunn whose telephone number is (703) 308-4865.

DAD

DAD  
22 December 1993

  
CONSTANTINE HANNAHER  
PRIMARY EXAMINER  
GROUP ART UNIT 2506